



7D AP-

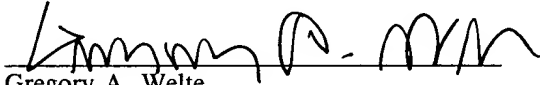
THE UNITED STATES PATENT AND TRADEMARK OFFICE

Assignee's Docket No.: 9040.00)
Group Art Unit: 3628)
Serial No.: 09/651,983)
Examiner: F. Poinvil)
Filing Date: August 31, 2000)
Title: Adaptive, Predictive)
System for Replenishing)
Currency in ATMs)

REPLY BRIEF

CERTIFICATE OF MAILING

I certify that this document is addressed to Mail Stop AF, Commissioner of Patents, PO Box 1450, Alexandria, VA 22313-1450, and will be deposited with the U.S. Postal Service, first class postage prepaid, on August 16, 2006.


Gregory A. Welte

This Reply Brief is submitted in response to the Examiner's Answer ("Answer" herein) mailed on June 16, 2006.

SUMMARY OF TWO MAJOR POINTS

1. The Answer makes numerous factual assertions, without showing the facts in the prior art.

-- For example, the Answer, page 18, discusses a particular approach to replenishing an ATM, but without showing that approach in the prior art.

09/651,983
Art Unit 3628
9040.00

-- For example, on page 19, the Answer asserts that, when an ATM is robbed by thieves, only two approaches are possible: (1) fight the thieves or (2) call law enforcement.

-- For example, on page 21, the Answer asserts that an ATM system "usually" contains a "plurality" of ATM (rather than a single ATM).

In effect, the Answer is relying on Official Notice, but without following the rules of Official Notice.

The factual assertions (except those which are indisputable) must be supported by evidence. They are not.

2. The Answer repeatedly admits that certain claim elements are missing from the references, but asserts those elements to be "obvious."

That is a mis-application of the law of obviousness. Those elements **must be shown in the prior art**. "Obviousness" is not a device to supply elements not shown in the prior art. That is done by asserting the elements to be "well known" or "inherent."

"Obviousness," by the terms of section 103, is only applicable to claims "as a whole." Only claims can be obvious, not missing elements.

END SUMMARY

09/651,983
Art Unit 3628
9040.00

RESPONSE TO ANSWER, SECTIONS 1 - 8 (PAGE 2)

These sections relate to formal matters, and require no reply.

RESPONSE TO ANSWER, SECTION 9 (PAGES 3 - 12)

These paragraphs repeat content of the Final Office Action, and have been addressed in the Appeal Brief.

re: ANSWER, PAGE 13

Point 1

The Answer, lines 3 and 4, asserts that certain similarities exist between the claimed invention and a "report" in the Clark reference. "Similarities" are irrelevant. The rejection is based on anticipation, so the **exact claim language** must be shown in the reference.

Point 2

The Answer, first full paragraph, third-to-last and second-to-last sentences, states that, in the invention, (1) the central computer performs a certain addition (to produce a total), and thus (2) "That total is part of the 'report' of claim 1(d)."

There is no basis for this conclusion (item (2) above).

Claim 1(d) does not require inclusion of this addition-step in the report, although the results of that step could be included

09/651,983
Art Unit 3628
9040.00

in the "report."

The Answer is reading recitations into claim 1(d) which are not present.

Point 3

The Answer, page 13, bottom, states that ". . . the language of claim 1 recites similar functions performed by Clark."

Again, similarity is irrelevant. The rejection is based on anticipation. The exact subject matter claimed must be found in Clark.

Point 4

The Answer, sentence bridging pages 13 and 14, asserts that the "replenished amount" is added to an amount estimated to be present within the ATM, and the sum is used in a "report."

That is irrelevant. Claim 1 does not recite that.

The Answer is relying on one embodiment of the invention.

The issue is whether Clark anticipates the claims, not an embodiment.

re: ANSWER, PAGE 14

Point 1

The Answer, page 14, line 3 et seq. asserts that in both Clark and the invention, "the operator does not prepare the report."

09/651,983
Art Unit 3628
9040.00

Appellant points out that, even if this assertion be true, it is irrelevant. Claim 1 does not state that the "operator does not prepare the report."

Claim 1 states:

. . . without using communications from parties performing the replenishment, preparing one, or more, reports concerning the ATMs replenished.

Point 2

The Answer, page 14, first full paragraph, states that Appellant argues that, in Clark, the input data is obtained from the technician, while "the claim states 'using the replenishment signals.'"

Appellant submits that this paragraph of the Answer is misleading.

The Answer implies that, in Clark, the entire content of the report is supplied by the technician. Appellant does not see that in Clark.

Further, the Answer implies that, under the claim, the entire content of the report comes from the "replenishment signals." The claim does not state that. The claim only states that the "replenishment signals" are "used" in the "report."

09/651,983
Art Unit 3628
9040.00

Point 3

The Answer, page 14, second full paragraph, asserts that a "replenishment signal" is inputted by the "technician" in both the invention and in Clark.

Appellant points out that this assertion is irrelevant. Claim 1 does not state that the "technician" inputs "replenishment signals."

Further, the Answer cites no support for its assertion that, in the invention, the "technician" issues "replenishment signals." Thus, the Answer's proposition lacks support, and cannot be considered.

Point 4

The Answer, page 14, second full paragraph concludes that

. . . in both the claimed invention and . . .
Clark, the replenishment signal is used
"without using communications from parties
performing the replenishment" to prepare one
or more reports concerning the ATMs
replenished.

However, several problems exist in this conclusion.

Problem 1

The Answer previously, in the same paragraph, stated that Clark's "replenishment signal" was inputted by the technician.

09/651,983
Art Unit 3628
9040.00

That is a "communication from parties performing the replenishment."

Claim 1(d) recites the **opposite**:

d) using the replenishment signals, and without using communications from parties performing the replenishment, preparing one, or more, reports concerning the ATMs replenished.

Problem 2

The Answer previously, in the same paragraph, stated that the technician of the present invention inputted a "replenishment signal" (that is false), which is used in preparing a report.

Point 5

The Answer, page 14, second full paragraph, states:

[In claim 1] the inputted signal is added to a previous sum and is used in preparing a report.

This is simply an incorrect statement, as a reading of claim shows.

Point 6

The Answer, page 14, end of second full paragraph, concludes that in "both the claimed invention and . . . Clark"

09/651,983
Art Unit 3628
9040.00

the replenishment signal is used "without using communications from parties performing the replenishment.

This is simply an incorrect statement. Claim 1 does not state this. The claim does not state that "the replenishment signal is used without etc. etc." Claim 1(d) states:

d) using the replenishment signals, and without using communications from parties performing the replenishment, preparing one, or more, reports concerning the ATMs replenished.

The Answer is rejecting the wrong claim.

Point 7

Summary of this Point

Appellant's Brief argued that Clark shows no automatic machinery which is able to generate a report, without input from a technician. Thus, Appellant concluded, Clark shows use of a technician's input, in generating a report, since Clark cannot generate the report without the technician's input.

The Answer states that this argument amounts to asserting that Clark lacks automatic machinery, which is not recited in claim 1.

The Answer is not correct. Appellant argued that the absence of automatic machinery in Clark shows that the technician must get involved in generating the report. That is opposite to claim 1,

09/651,983
Art Unit 3628
9040.00

which states that a "report" is "prepared" "without using communications from parties performing the replenishment."

The absence of automatic machinery in Clark shows that the technician must provide some "communications" for the report. That is contrary to claim 1.

Claim 1 is not required to recite the absence of the machinery, in order to for the Brief to discuss the implications of the absence of the machinery.

End Summary

The Answer, page 14, bottom, asserts, in essence, that Appellant argues that an element asserted to be absent from Clark is not recited in the claims.

Appellant here repeats his argument:

Previous Argument in Brief (Page 14)

The PTO previously relied on Clark, column 6, lines 50 - 53, to show claims 1(c) and (d). That Clark-passage states:

An updated ATM STATUS REPORT
based on the input data
is sent to the host computer in step 138.

Applicant points out that "the input data" is obtained from the technician performing the replenishment. That "input data" is described in column 6, line 46 et seq., and is punched in by the

09/651,983
Art Unit 3628
9040.00

technician on keypad 27, within the ATM, in Clark's Figure 2. That "input data" indicates the type and number of bills replenished.

That is contrary to the **highlighted** section of claim 1(d), which is repeated here:

d) using the replenishment signals, **and without using communications from parties performing the replenishment**, preparing one, or more, reports concerning the ATMs replenished.

From another point of view, Clark discusses no mechanism or device which can generate the ATM STATUS REPORT automatically, and without the involvement of the technician. Plainly, input from the technician is required for this ATM STATUS REPORT, contrary to claim 1(d).

End Previous Argument

Appellant points out that the Answer distorts Appellant's position. Appellant **IS NOT arguing** that Clark does not show claim 1 on the grounds that Clark does not show automatic report generation.

Instead, Appellant argues that, because Clark fails to show automatic report generation, **Clark requires the input of the technician, for data to include in the report.**

Since Clark **requires** that input, his report **cannot be generated** "without using communications from parties performing the

09/651,983
Art Unit 3628
9040.00

replenishment" as recited in claim 1(d).

Appellant was simply showing that the absence of the automated machinery in Clark has a certain implication, namely, that the technician must supply certain data for the report. That is contrary to claim 1(d). Claim 1(d) is not required to recite the machinery, or its absence, in order for the implication to exist.

Point 8

The Answer, page 14, bottom, asserts that it is unclear in claim 1 "what or who is preparing the report."

Appellant points out that claim 1 is a **method claim**. Claim 1 is not required to state "what or who" prepares the report.

re: ANSWER, PAGE 15

Point 1

The Answer is self-contradictory.

The Answer, page 15, first and second paragraphs, asserts that Clark's technician (or "operator" in the second paragraph) enters a replenishment amount. The Answer asserts that this corresponds to the claimed "replenishment signals."

But this ignores the fact that this is also a "communication" from a "party performing the replenishment" as in claim 1(d). Claim 1(d) prohibits using such "communication" in preparing the "report."

09/651,983
Art Unit 3628
9040.00

The Answer admits that such "communication" is used in preparing Clark's "report." (Paragraph 2.)

Point 2

The Answer, page 15, second full paragraph, states that some operation in Clark is "similar to the claimed replenishment signal."

"Similarity" is not sufficient. The claimed replenishment signal, exactly as recited, must be shown in Clark.

Point 3

The Answer, page 15, third and fourth full paragraphs, apparently refers to the Brief, section entitled "POINT 2," which begins on page 15.

This section of the Brief pointed out that the PTO was being inconsistent.

The Answer's statement that "no party is being claimed to prepare the report" does not resolve the contradiction.

The contradiction lies in the PTO's assertions, not the claims.

Point 4

The Answer incorrectly quotes Appellant's Brief.

The Brief states the following on page 13, regarding the

09/651,983
Art Unit 3628
9040.00

invention:

- The technician replenishes the currency.
- The technician locks up the ATM.
- "... the ATM sends a signal to the central computer."

The Answer quotes this as follows:

"A technician replenishes currency as in claim 1(b) . . . transmits the signal to a central computer and the central computer treats that signal as the replenishment signal of claim 1(c)."

That quote is a **falsification of Appellant's statement.**

Appellant said that the **ATM** sent the signal. The Answer's quote falsely indicates that the **technician** sent the signal.

re: ANSWER, PAGE 16,

Page 16, First and Second Full Paragraphs

The Brief addresses the Answer's position.

Page 16, Third Through Fifth Paragraphs

The Brief, page 17, section headed "POINT 5" addresses the Answer's position.

09/651,983
Art Unit 3628
9040.00

Page 16, Last Paragraph, Page 17, First Paragraph

Point 1

The Brief, page 23, section headed "Claim 3" addresses the Answer's position.

Point 2

SUMMARY OF THIS POINT

The Answer asserts that Clark's technician punches in the "replenishment signals" of claim 3. However, claim 3 depends from claim 1. In claim 1, the "replenishment signals" are "received from replenished ATMs." That has not been shown in Clark.

END SUMMARY

The Final Office Action asserted that columns 5 and 6 of Clark show claim 3. Claim 3 is here repeated:

3. Method according to claim 2, wherein the replenishment signals indicate contact with an ATM by a party other than a customer in the normal course of business.

The Brief stated that the undersigned attorney examined those columns of Clark, and could not locate claim 3 therein. Thus, the Brief concluded, claim 3 has not been shown in the references.

The Answer, page 17, top, in apparent rebuttal to the Brief's

09/651,983
Art Unit 3628
9040.00

conclusion, states:

. . . both columns 5 and 6 recite that the technician in contact with the ATM inputs a replenishment amount in the ATM as such [sic] is stored in the memory of the ATM 10.

Appellant is directed to column 5, lines 45 - 66 and column 6, lines 40 - 53 of Clark.

However, this statement of the Answer fails to rebut the Brief's conclusion. Claim 1 is part of claim 3. It is clear that the four processes of claim 1(a) - (d) (ie, the "identifying," "causing," "receiving," and "using" processes) are performed by a central computer, and not by the ATM being replenished.

As to the "replenishment signals" of claim 3, parent claim 1 states that they are "received" from the replenished ATM. That is, claim 1(c) states:

c) receiving replenishment signals from the replenished ATMs.

The Answer has not shown this. The Answer, in attempting to show claim 3, merely asserts that dollar amounts punched into the ATM by the technician in Clark qualify as the "replenishment signals" of claim 3.

That is not sufficient. It must be shown that the "replenishment signals" of claim 3 correspond to those of claim 1(c), which recites "receiving replenishment signals from the

09/651,983
Art Unit 3628
9040.00

replenished ATMs." The Answer has not shown that the dollar amounts punched in by the technician in Clark are "received" as in claim 1(c).

The Answer has merely asserted that the ATM receives and stores the dollar amounts. That is insufficient: claim 1(c) does not recite that.

Point 3

Claim 3 states that "the replenishment signals indicate contact with an ATM by a party other than a customer in the normal course of business." The PTO has not shown how the dollar amounts punched in by the technician in Clark "indicate" the claimed "contact."

Page 17, Second Paragraph

Point 1

The Answer asserts that a burglar in Clark would cause a "replenishment signal" to occur. Appellant points out that this assertion is contrary to the Answer's assertion that the dollar amounts punched in by the technician in Clark qualify as "replenishment signals."

As a minimum, Appellant submits that the PTO must explain how these entirely different agencies (burglar and technician) **both** produce the claimed "replenishment signals," as the Answer asserts.

09/651,983
Art Unit 3628
9040.00

How does a signal by a burglar produce a "replenishment signal from" a "replenished ATM" as in parent claim 1(c) ?

Point 2

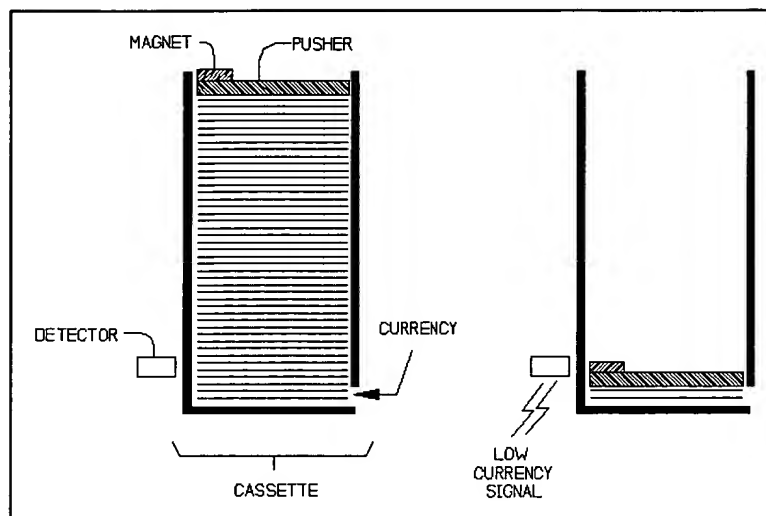
A description of the Clark reference is here required. Appellant repeats the description given in the Brief.

CLARK REFERENCE

Clark indicates that, in ATMs, a magnet is commonly positioned on a "pusher" in a stack of currency held in a cassette. The cassette dispenses the currency to customers. As the currency is dispensed, the magnet will be lowered, since the stack of currency becomes shorter. Eventually, the magnet reaches a point where it actuates a reed switch, indicating that the cassette should be replenished. (Column 1, lines 16 - 28.)

Sketch 1, below, is a schematic of the situation.

09/651,983
Art Unit 3628
9040.00



Sketch 1

The DETECTOR in the Sketch corresponds to Clark's reed switch. When the stack of currency becomes sufficiently depleted, a LOW CURRENCY SIGNAL is issued by the DETECTOR, because the MAGNET has been moved adjacent the DETECTOR, and the DETECTOR detects the magnetic field.

Applicant here points out that the DETECTOR (ie, Clark's reed switch) is "mounted within the ATM." (Column 1, line 27.) Thus, when the CASSETTE is removed, the DETECTOR remains in place. This will be significant to claim 4, as discussed below.

Clark discusses this detection scheme in his Background. However, it is not clear whether

(A) this type of detection is used in Clark's invention

09/651,983
Art Unit 3628
9040.00

or

(B) Clark is only pointing to the presence of
this type of detection in his prior art.

The lack of clarity stems from the fact that Clark is not concerned with detection of low levels of currency. Instead, he is concerned with a particular problem caused by cassettes containing the low levels of currency.

Clark states that those partially empty cassettes are transported to the bank owning the ATM. Clark states that this approach provides opportunities for theft of currency from the cassettes: technicians are in possession of partially empty cassettes, which contain money which can be stolen. (Column 1, lines 56 - 65.) Theft is the problem.

Clark's invention solves this problem, by eliminating transport of the partially empty cassettes, in a manner which will now be explained. (See column 7, top.)

Clark discusses a replenishment sequence.

- 1) A technician visits an ATM.
- 2) The technician punches in his ID data on the customer keypad. If the technician's ID is verified, the technician is allowed to place the ATM into "supervisory mode," wherein it will not respond to customers. (Column 5, lines 49 - 57.)

09/651,983
Art Unit 3628
9040.00

3) If the technician selects a "replenish" option, then the ATM generates a status report. This status report indicates the current contents of each cassette within the ATM. (Column 5, line 66 - column 6, line 7.)

Applicant points out that this status report **IS NOT** printed if the technician **DOES NOT** select "replenish." (Figure 5, "NO" branch of decision block 126.)

4) The technician may select a "purge" operation, wherein partially empty cassettes are emptied into a storage device. (Column 6, line 8 et seq.) The now-purged, and empty, cassettes can be returned to the bank.

5) Whether or not "purge" is selected, the technician then replaces empty cassettes with full cassettes. The technician, using key pad 27 in Clark's Figure 2, which is inside the ATM (Column 3, lines 9 - 13), informs the "host computer" at the bank of the type and amount of bills replenished. (Column 6, lines 41 - 67.)

The "host computer" is informed by way of

09/651,983
Art Unit 3628
9040.00

an ATM STATUS REPORT. (Column 6, lines 52,
53.)

APPLICATION OF CLAIM 4 TO CLARK

Claim 4 recites:

4. Method according to claim 3, wherein
entry into an ATM by a burglar causes a
replenishment signal to occur.

Comment on Claim 4

To explain claim 4, Applicant points out that, in one form of the Invention, the ATM is equipped with a burglar alarm. If the door of the ATM is opened, the burglar alarm notifies a central computer.

However, the central computer knows when a technician is to service the ATM. If the burglar alarm goes off at that time, the central computer assumes that the technician opened the door, and not a burglar. The burglar-alarm-signal is treated as a "replenishment signal." If a replenishment signal occurs at other times, it is assumed to be caused by a burglar.

The Rejection

The Answer presumes that a specific type of theft occurs in Clark, and that such a theft causes the LOW CURRENCY SIGNAL of Sketch 1, above, to occur. In these presumptions, the PTO purports

09/651,983
Art Unit 3628
9040.00

to find claim 4 obvious, based on Clark.

However, several problems arise in the PTO's approach.

PROBLEM 1

The specific type of theft has not been shown in the prior art, and other types of theft can **fail to result** in the LOW CURRENCY SIGNAL being issued.

For example, if the burglar removes only a handful of currency in Sketch 1, above, the MAGNET will not fall to a sufficiently low level to activate the DETECTOR.

As another example, it may be assumed that, if a burglar succeeds in gaining entry to an ATM, the burglar knows the basic operation of the ATM. Accordingly, based on this knowledge, the burglar can remove CURRENCY, and replace it with newspaper, to thereby prevent the MAGNET from actuating the DETECTOR.

As another example, the burglar can remove the PUSHER entirely, thereby preventing the MAGNET from actuating the DETECTOR, even if all the CURRENCY is removed.

As another example, the burglar can remove the entire CASSETTE. That does not cause the LOW CURRENCY SIGNAL to arise, because the MAGNET has been removed from proximity of the DETECTOR.

Therefore, the PTO presumes a **specific type of theft** occurs in Clark. But other types of theft are possible, as just explained.

09/651,983
Art Unit 3628
9040.00

The PTO is arguing that its specific type of theft is "inherent" in Clark. MPEP § 2112 states:

EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE
TENDING TO SHOW INHERENCY.

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art.

No such "basis in fact and/or technical reasoning" have been shown.

PROBLEM 2

The type of theft on which the PTO relies has not been shown in the prior art. MPEP § 2143.03 states:

To establish prima facie obviousness . . . **all the claim limitations** must be taught or suggested by the prior art.

PROBLEM 3

The LOW CURRENCY SIGNAL of Clark, which the PTO uses to show claim 4, does not actually qualify as a "replenishment signal" as that term is used in the parent claims.

Parent claim 1(c) recites:

c) receiving replenishment signals from the replenished ATMs.

09/651,983
Art Unit 3628
9040.00

The LOW CURRENCY SIGNAL of Sketch 1 is not issued by a "replenished ATM." It is issued by an ATM **needing replenishment**.

Restated, under claim 1, "replenishment signals" are issued by ATMs **which have been replenished**.

Therefore, the "replenishment signal" of claim 4, which must correspond to the "replenishment signal" of the parent claims, cannot correspond to the LOW CURRENCY SIGNAL of Sketch 1, above.

Page 17, Third and Fourth Paragraphs

The Brief, page 24, section entitled "Claim 10" addresses the Answer's position.

re: ANSWER, PAGE 18

Point 1

The Brief, page 25 et seq., section entitled "RESPONSE TO 103 - REJECTION OF CLAIMS 6, 7, and 9," addresses the Answer's position.

Point 2

Claim 6(b), speaking generally, states that estimates are made of the currency contained in ATMs, and the estimates are used to identify a "subset" of ATMs to be re-stocked with currency.

The Answer, page 18, gives an extended discussion as to why

09/651,983
Art Unit 3628
9040.00

claim 6(b) is obvious, based on Clark. However, nowhere in this discussion does the Answer explain where the "estimates" are made in Clark.

In fact, the discussion, page 18, merely **presupposes** that the central computer somehow learns that certain ATMs need restocking, and takes appropriate action. That fails to show claim 6(b). No "estimates" have been shown.

Point 3

The Answer's discussion on page 18 merely sets forth

- 1) subject matter shown in Clark, and
- 2) modifications which could be made in Clark.

The discussion says nothing more than "Clark can be modified in a certain way to show the claims in question."

The MPEP prohibits this type of rejection. MPEP § 2143.01 states:

FACT THAT REFERENCES CAN BE COMBINED OR MODIFIED IS NOT SUFFICIENT TO ESTABLISH PRIMA FACIE OBVIOUSNESS

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

. . . .

FACT THAT THE CLAIMED INVENTION IS WITHIN THE

09/651,983
Art Unit 3628
9040.00

**CAPABILITIES OF ONE OF ORDINARY SKILL IN THE
ART IS NOT SUFFICIENT BY ITSELF TO ESTABLISH
PRIMA FACIE OBVIOUSNESS**

A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references.

Point 4

The Answer's discussion on page 18 fails to follow the law of obviousness.

This discussion tacitly admits that several claim elements are absent from Clark, but asserts that these elements are "obvious." However, "obviousness" is not a device for supplying missing claim elements, which are not shown in the prior art.

The missing claim elements include the following:

- The claimed "packets" (which are asserted to be "obvious"). (Page 18, line 9.)
- Treating certain signals in Clark in a certain way (which is asserted to be obvious.) (Page 18, last four sentences.)

The MPEP sections cited immediately above prohibit this type of rejection.

The Answer is merely asserting that Clark can be modified in

09/651,983
Art Unit 3628
9040.00

a certain way, and that it is obvious to do so. That is insufficient under the rules of obviousness.

"Obviousness" is not a device to supply elements not shown in the prior art. That is done by asserting the elements to be "well known" or "inherent."

"Obviousness," by the terms of section 103, is only applicable to claims "as a whole." Only claims can be obvious, not missing elements.

re: ANSWER, PAGE 19

Page 19, First Paragraph

Claim 6(g) states:

g) ascertaining whether the signals were
 issued by an ATM within the subset.

The Answer merely asserts that sufficient information is present within Clark's system to perform the claim recitation.

That is insufficient to show the claim to be obvious.

Further, Appellant submits that this paragraph of the Answer is factually incorrect. For example, this paragraph asserts that owners of ATMs "must" store data relating to the ATMs in a "central computer." The undersigned attorney points out that many convenience stores own their own ATMs, for the purpose of drawing customers into their stores. Where is the "central computer" which

09/651,983
Art Unit 3628
9040.00

stores data indicating the "status" of this ATM ?

Therefore, Appellant submits that the factual representations of this paragraph cannot be accepted, without evidence.

From another point of view, this paragraph is asserting that certain facts are "well known." In response, Applicant traverses the assertions, and requests that a reference be cited in support of the assertions. (See MPEP § 2144.03.)

Page 19, Second Paragraph

Claim 6(g) recites:

- g) ascertaining whether the signals were
 issued by an ATM within the subset and
 - i) if not, contacting a law enforcement
 agency,

Point 1

The Answer admits claim 6(g)(i) to be absent from Clark. Again, the Answer asserts that 6(g)(i) is "obvious," but without showing that claim recitation in the prior art.

The claim recitation must be shown in the prior art. "Obviousness" is not a device for supplying missing claim recitations.

Point 2

The Answer's reasoning applies a false dichotomy.

09/651,983
Art Unit 3628
9040.00

The Answer pre-supposes that, when a thief breaks into an ATM, only two possible responses exist:

- (1) "fight" the thieves
- or
- (2) contact law enforcement.

The Answer argues that, since it is not "proper" to "fight" the thieves, therefore, law enforcement should be contacted.

However, numerous problems exist in this false dichotomy.

PROBLEM 1

One problem is the false dichotomy itself. Why are those the only two possibilities ? Why can't the owner of the ATM do nothing, and rely on his insurance to cover the loss ?

Or why can't the owner make the ATM so impregnable, that the thieves can never break in ?

Or why can't the owner place the ATM in a high-traffic area, so that thieves would necessarily be detected if they try to break in, and thus the thieves are deterred ?

Thus, the Answer asserts that (1) only two courses of action are possible, (2) one of the actions cannot be taken, so that, therefore, (3) the other action must be taken.

That is a false dichotomy. The Answer is not applying the rules of logic correctly.

And the false dichotomy has not been shown in the prior art.

09/651,983
Art Unit 3628
9040.00

PROBLEM 2

Even accepting the dichotomy as valid, what is wrong with "fighting" the thieves ? That is, why can't the owner of the ATM hire armed security guards to protect the ATM ?

The conclusion that law enforcement must be called does not follow from the premise (the false dichotomy).

PROBLEM 3

The dichotomy is false for another reason.

The dichotomy pre-supposes that somebody is present who would "fight" with the thieves. But that is simply not the case.

Thus, the dichotomy presents two possible courses of action, one of which will, in practice, never occur (the "fighting" option).

That is, the dichotomy, in point of fact, is saying: "Either A or B must occur." But, in practice, A never occurs. Therefore, the initial statement, in essence, asserts that B must always occur, because A should not occur.

It is completely arbitrary to assert that B must always occur. Arbitrary statements cannot be used to reject claims.

From another point of view, in essence, the initial statement (the false dichotomy) states that law enforcement must be contacted. But it exalts form over substance, by burying that

09/651,983
Art Unit 3628
9040.00

assertion as a conjunction with another assertion ("fighting" could be done). But, since in practice, no one is present to "fight," the "fighting" option will never occur.

The initial statement is like saying "I will either play golf or win 100 million dollars in the lottery." In actual practice, that statement says nothing more than "I will play golf."

Similarly, the initial statement says nothing more than "law enforcement must be contacted." That is completely arbitrary.

Point 3

The type of contacting of law enforcement, which is contained in the claim, is not shown in the references. The Brief, beginning on page 28, section entitled "Example 5," explains this.

As the Brief explains, Ross causes "law enforcement" to be contacted in **only one situation**, namely, when he detects "forced entries by criminals into the safe 17." (Column 8, line 16.)

Claim 6 does not recite that. Claim 6(g) is here repeated:

- g) ascertaining whether the signals were
 issued by an ATM within the subset and
- i) if not, contacting a law enforcement
 agency.

Point 4

Claim 6(g) states in full:

09/651,983
Art Unit 3628
9040.00

g) ascertaining whether the signals were issued by an ATM within the subset and

i) if not, contacting a law enforcement agency;

ii) if so, adjusting the estimate of the currency stored within that ATM.

Thus, one of two events occur, in response to the "signals:"

-- "law enforcement" is contacted, or
-- the "estimate" of "currency stored within that ATM" is "adjusted."

This **twofold mode of operation** has been shown **nowhere** in the references.

Page 19, Third Paragraph

Regarding the two alternate events discussed in the "Point 4" immediately above, the Answer, page 19, third paragraph, asserts that making the "estimate" is obvious for accounting, etc., purposes.

However, this assertion ignores the **conditions** which cause the "estimate" to be made. Those conditions of claim 6 include

-- "signals" being received which indicate "interaction with the ATM by a party other than a customer;"
-- ascertaining whether the "signals" were issued by an "ATM within the "subset;"

09/651,983
Art Unit 3628
9040.00

and

-- the "subset" was identified, or defined,
based on "estimates."

Therefore, for example,

-- If "signals" were received from an ATM
outside the subset, no "estimate" is made.

-- If no "signals" are received, no
"estimate" is made (and "law enforcement" is
not called).

-- The "estimate" is made only if the
"signals" are received from an ATM "within the
subset."

Consequently, the PTO's motivation of making the "estimate" has no relevance to the situation. The PTO's motivation is to foster "inventory, tracking, and accounting." But that has no relevance to the situation.

For example, as explained above, if no "signals" are received from an ATM in a "subset," no "estimate" is made. Thus, under the PTO's reasoning, no accounting etc. is done, if no "signals" are received. That makes no sense. That means that, if customers are not withdrawing money from ATMs, so that no re-stocking occurs, then the bank's accounting practices shut down.

As another example, as explained above, if the "signals" are received from outside the subset, then no "estimate" is made.

09/651,983
Art Unit 3628
9040.00

(Because those signals mean that the ATM is being robbed: "law enforcement" is contacted instead.) Under the PTO's reasoning, the bank's accounting practices shut down because of the robbery of an ATM. That makes no sense.

Therefore, stating the preceding in a different way, Appellant points out that the PTO's rationale for performing the "estimating" step of claim 6(g)(ii) is based on a generic assertion that banks perform accounting and related operations. According to that generic assertion, certain "estimating" occurs.

But that is not the "estimating" which is claimed. Nor does that reasoning lead to the claimed "estimating" which only occurs under the conditions claimed.

re: ANSWER, PAGES 19 AND 20

Point 1

The Brief, page 30, paragraph beginning with "In addition, Applicant submits . . .," asserts that the PTO interprets Ross in a manner which is contrary to common sense. The Brief points out that Ross uses microphones to detect unusual sounds in an ATM. But when the technician in Ross visits an ATM, he "shuts down" the ATM.

Thus, it is reasonable to conclude that the microphones shut down too. (Why would they continue to operate ? They have nothing to detect.)

However, the PTO assumes that Ross's microphones **continue to**

09/651,983
Art Unit 3628
9040.00

operate during shut-down. That is the interpretation which defies common sense.

Point 2

In an attempt to rebut Appellant's conclusion (that Ross is being interpreted contrary to common sense), the Answer presents an argument on page 20, first paragraph. This rebuttal fails.

re: First Attempted Rebuttal

The first attempted rebuttal is the assertion that Ross alerts law enforcement when abnormal activity is detected. However, this assertion is technically incorrect. As explained above, Ross only alerts law enforcement when he detects forced entry into his "safe." The assertion is that Ross alerts law enforcement when **any type of abnormal activity is detected**. That is incorrect.

Further, this assertion does not rebut Appellant's assertion that Ross is being interpreted contrary to common sense. Ross is being interpreted as operating his microphones while the ATM is shut-down. That is contrary to common sense. The attempted rebuttal does not show that the microphones are also turned off during shut-down (which **does** make sense).

re: Second Attempted Rebuttal

The second attempted rebuttal is that "common sense" would

09/651,983
Art Unit 3628
9040.00

dictate alerting law enforcement in case of abnormal activity at an ATM. However, several problems exist here.

PROBLEM 1

The "common sense" has not been shown in the prior art.

PROBLEM 2

The "common sense" "practice" (of alerting law enforcement of abnormal activity) does not rebut the Brief's assertion that the microphones do not operate in Ross during shut-down.

Appellant still contend that the PTO is attributing a mode of operation to Ross which defies common sense. That mode is maintaining the microphones in operation, while the ATM is shut-down

PROBLEM 3

Appellant submits that the second attempted rebuttal is factually incorrect, or at least too vague to be useful.

The undersigned attorney has an ATM card. Within the last month, he went to the ATM at the brick-and-mortar bank which issued the card. He tried numerous times to withdraw cash, but the ATM made no response. After a few minutes, a person came out of the bank, and informed him that the ATM was not working.

Thus, the ATM was operating abnormally. Yet, apparently no

09/651,983
Art Unit 3628
9040.00

one in "law enforcement" was contacted.

Thus, ATMs can suffer malfunctions, and operate abnormally, without "law enforcement" being notified.

PROBLEM 3

The second attempted rebuttal is written in the passive voice. It presumes that some agency (robot, human, or other) is present which is capable of notifying law enforcement. But no factual basis for this presumption has been given.

Appellant submits that a factual basis must be set forth, which justifies the presumption.

Restated, if the agency (robot, human, other) is not present, it is **impossible** to perform the notification which the PTO proposes. Thus, the PTO must present evidence as to **how it is possible** to perform that notification.

re: Page 20, Second and Third Paragraphs

Claim 7 recites:

7. Method according to claim 6, wherein
no person directly reports replenishment
currency supply of any ATM.

The Answer previously stated (page 16, second full paragraph) that the operator in Clark "enters the replenishment signal" to the ATM.

09/651,983
Art Unit 3628
9040.00

The Answer previously stated (page 15, second full paragraph) that the operator in Clark "inputs the replenishment amount" to the ATM. Then the Answer states that this "replenishment amount" is used to prepare a report.

Thus, the Answer admits that Clark is contrary to claim 7. Further, the Brief, page 31, shows that Clark is contrary to claim 7.

Therefore, Clark does not show claim 7.

The Answer, page 20, apparently now tries to argue that, because some reports are generated in Clark without involvement of the technician, that claim 7 is shown. However, that argument fails. Even if such reports are present, that does not contradict the fact that Clark's technician enters the dollar amount replenished, contrary to claim 7.

re: Page 20, Fourth Paragraph

The Brief, page 31, states that claim 9 is seen as patentable, based on its parent claim 7. Thus, there is no reason to address the Answer's contention.

re: Page 21, First Paragraph

The first sentence of this paragraph asserts "there usually exist a plurality of ATMs." This has not been shown in the prior art.

09/651,983
Art Unit 3628
9040.00

The second sentence asserts that, whenever funds in an ATM are depleted, "replenishing . . . would have been imminent." That has not been shown in the prior art.

The third sentence is irrelevant. Any benefits of using the supposed "list" (eg, "providing a well structured system") are irrelevant. Other approaches exist, wherein no list is used, and the technician simply visits ATMs with a suitcase full of money, and fills the ATM. Appellant's Background of the Invention, contained in the Specification, discusses such an approach. The PTO has not disputed the accuracy of this discussion.

Another approach which exists is to equip the technician with full cassettes of cash. The technician simply removes cassettes in the ATM, whether empty or not, and replaces them with the full cassettes. The Clark reference discusses this.

Therefore, the mere fact that using the claimed "list" provides certain benefits does not lead to the claim in question. Other approaches are known in the art, and they do not lead to the claim.

Further, the third sentence of the paragraph of the Answer relies on a "list." As the Brief explains (pages 33 and 34, section entitled "Problem 2") no "list" has been shown in the prior art. Thus, the PTO is using Appellant's own Specification as a teaching for rejecting the claims. (Because the only mention of a "list" is in the Specification.)

09/651,983
Art Unit 3628
9040.00

That is not allowed.

In addition, the Brief, page 42, section entitled "Point 2" addresses the Answer's assertion that the reference shows a single computer, but "for illustration purposes." The Brief discusses the Ross reference, but the Brief's discussion still applies: the reference discusses a single ATM because nothing more is required for the reference to explain its invention.

The multiple ATMs claimed have not been shown in the prior art.

re: Page 21, Second Paragraph

The Brief, page 34 and 35, section entitled "Claim 8(b) and (c)" rebuts the Answer.

The Answer asserts that a report containing three things is "obvious" based on Clark. However, those three things have not been shown in the prior art. "Obviousness" is not a substitute for showing the claim elements within the prior art.

Further, the Answer asserts that this report, containing three elements, is obvious based on Clark, because Clark teaches preparing a report both before and after replenishment. Even if Clark does that, the claimed report containing three elements does not follow, as a matter of logic, from what Clark does.

One reason is that the Answer admits that Clark does not show the three elements. The three elements are said to be "obvious."

09/651,983
Art Unit 3628
9040.00

Since Clark supposedly prepares the two reports, and the two reports do not contain the three elements, Appellant asks: "Why does it follow, as a matter of logic, that the three elements should be contained in the reports ?"

That is, if Clark's reports do not contain the three elements, why should they be added ?

Further, even if Clark's reports contain the three elements (which is not so), Appellant points out that the PTO relies on **TWO** reports in Clark. The claim recites a report prepared when signals are received indicating that an ATM has been entered. Where is the teaching to replace Clark's two reports by the claimed one ?

re: Page 21, Third Paragraph

Claim 11 recites:

11. Method according to claim 8, wherein the report is generated after the signals are received.

The third paragraph of page 21 of the Answer merely asserts that the "ATM which is in communication with the remote computer prepares the report."

That does not show claim 11.

re: Page 21 - 23, Answer's Discussion of Claim 5

Point 1

09/651,983
Art Unit 3628
9040.00

Appellant submits that the Answer is illogical.

The Answer asserts that whenever a user is using an ATM, Clark detects entry of the technician, and issues an entry signal. (Page 22, first paragraph, first full sentence.)

It then implies (but does not show) that, when replenishment occurs, the entry signals are issued by the ATM. Then it states that the replenished ATMs are designated as such. Appellant points out that the ATMs cannot be designated as replenished unless they issue some type of signals, such as replenishment signals.

Appellant points out that this operation, as described in the Answer, makes no sense. It requires the technician to replenish the ATM when a customer is present. That is, it states that the entry signals are only issued "whenever a user is using the system." (Answer, page 22, first full sentence.) Thus, only if a technician enters the ATM **when a customer is using the ATM** are the "entry signals" issued. That makes no sense.

Point 2

The Answer, in fact, fails to show the claimed "entry signal." Claim 5(c), "designates" the ATMs "when entry signals are received."

In addition, if no "entry signals" are shown, then the claimed "designating" "when entry signals are received" is also absent.

Two claim recitations are missing.

09/651,983
Art Unit 3628
9040.00

Point 3

Numerous elements have not been shown in the prior art. Instead, those elements are asserted to be "obvious."

Appellant repeats: "obviousness" is not a substitute for showing all elements of the claim in the prior art.

Examples of missing elements are these:

- The scheduling of replenishment of a group of ATMs during a time period. (Answer, page 22, first paragraph, second full sentence; first full paragraph, first sentence.)
- The designating of ATMs as replenished, after replenishment. (Answer, page 22, first full paragraph, last sentence.)
- Keeping records or designating ATMs as replenished. (Answer, page 23, last sentence prior to section (11).)

The Answer asserts these elements to be "obvious," but they have not been shown in the prior art. MPEP § 2143.03 states:

To establish prima facie obviousness . . . **all the claim limitations** must be taught or suggested by the prior art.

Point 4

The Answer (page 22, first full paragraph) asserts that

09/651,983
Art Unit 3628
9040.00

designating ATMs as replenished is obvious, and gives a reason why the designating step is useful. However, claim 5(c) states that the designating is done "when the entry signals are received."

Thus, the Answer merely asserts "designating" to be obvious, but the claim does not recite mere "designating." The claim recites "designating" "when the entry signals are received." The Answer has not shown the claimed TYPE of designating ("when the entry signals are received") in the prior art.

Point 5

The Answer, page 22, bottom, asserts that "funds from ATMs are usually taken [by] users or by forced entry from thieves." This is an assertion of a fact, with no supporting evidence given. Evidence is required.

It appears that the Answer is invoking Official Notice. In response, the undersigned attorney respectfully traverses the official notice, and requests a citation of evidence in support of the Answer's position. (See MPEP § 2144.03.)

One reason is that the Answer's statement appears to be incorrect. Other ways exist in which "funds from ATMs are . . . taken." For example, Ross states that the technicians remove partially filled cassettes of cash.

As another example, the undersigned attorney has read a newspaper story wherein thieves stole an entire ATM.

09/651,983
Art Unit 3628
9040.00

The PTO is arguing that its specific type of theft is
"inherent" in Clevo..t<74\..t=44\MTET.t5454\..t5554\6556.t5664\wtetew>.t<7

09/651,983
Art Unit 3628
9040.00

Therefore, the Answer's assertion as to the usual modes of removal of funds from ATMs cannot be used.


Point 6

The Answer, page 23, asserts that (1) keeping records of the time and personnel who replenish ATMs and (2) identifying the ATMs as replenished is "obvious." Again, those actions have not been shown in the references. "Obviousness" is not a substitute for showing the claim elements in the prior art.

CONCLUSION

Appellant requests the Board to overturn all rejections, and pass all claims to issue.

Respectfully submitted,



Gregory A. Welte
Reg. No. 30,434

NCR Corporation
1700 South Patterson Blvd
WHQ - 3
Dayton, OH 45479
August 16, 2006
(937) 445 - 4956